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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,896	02/13/2002	Joy M. Campbell	P04890US1	6473

21186 7590 04/14/2006

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
BERTOGLIO, VALARIE E	

ART UNIT	PAPER NUMBER
1632	

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/074,896	CAMPBELL ET AL.	
	Examiner	Art Unit	
	Valarie Bertoglio	1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03/21/2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8-14 and 17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8-14 and 17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on *N/A* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/21/2006 has been entered.

Claims 1 and 8 have been amended. Claims 7,15,16 and 18-30 have been cancelled. Claims 1-6,8-14 and 17 are pending and under consideration in the instant office action.

Claim Objections

The objection to claims 5 and 6 is withdrawn in light of Applicant's amendment to the specification.

Double Patenting

The rejection of claims 1-4, 8,9, 11-14 and 17 is maintained under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 6-8 of U.S. Patent No. 6,004,576. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims encompass a method of feeding poultry an animal supplement comprising spray-dried animal plasma. Therefore the claims of '576 anticipate the instant claims.

Applicant has not presented any new arguments to the rejection under double patenting. The rejection is maintained for reasons of record set forth on pages 2-3 of the office action

mailed 09/01/2004. Applicant's arguments in the reply of 10/31/2005 are addressed in the advisory action of 03/06/2006.

The difference between '576 and the instant invention is only the outcome, which is the effect that is naturally carried out in the poultry in the identical processes of '576 and the claimed invention. There is nothing different about the poultry of the instant claims that would render the outcome of the claimed method any different than that of the methods of '576. The instant specification shows that practicing the method of claim 7 of '576 results in increased breast meat in the broilers. "Discovery of new property or use of previously known composition, even if unobvious from prior art, cannot impart patentability to claims to known composition". In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Practicing claim 7 of '576 cannot occur without infringing on the claims 1-4, 7-9, 11-14 and 17, 29 and 30 of the instant invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of claims 1-4,8-14 and 17 is maintained under 35 U.S.C. 102(b) as being anticipated by Weaver (US 6,004,576, 1999). Applicant's arguments have been thoroughly

considered and are not found persuasive. The rejection is maintained for reasons of record set forth on pages 8-9 of the office action mailed 09/01/2004.

Applicant has argued that the claimed invention is a new and unobvious use of an "old" composition of matter. In response, this argument is not relevant to the instant rejection. The claims are directed to a newly recognized result or characteristic of an old process. The difference between the instant invention and that of '576 is which characteristic of the outcome of an identical method is being recited in the claims.

Applicant argues that while Weaver provided teachings of feeding the spray-dried plasma to avian species, there is no disclosure in Weaver that would lead one to do so to alter the ratio of breast to thigh meat. Applicant has cited *In re Marshall* in setting forth that the court reversed a rejection of claims directed to the use of an anesthetic, previously used in treating gastric disorders, to inhibit digestion, leading to weight loss. *Marshall* represents a new use of an old compound, oxethazaine. In *Marshal*l, the patients being treated with the anesthetic are different. The treatment is different. In the instant case, the poultry being fed the spray-dried supplement are the same as those of '576. *Marshall* is directed to different uses, including methodology, of the same product that would lead to different results in different patients. In the instant case, the same method steps, using the same product, are carried out on the same type of organism, normal poultry. The increase in breast to thigh or leg meat claimed in the instant Application is merely a characteristic of the increased weight gain observed as a result of the same method of Weaver. That Weaver ('576) did not mention or was unaware that the weight gain resulting from the claimed method would affect breast muscle more than thigh muscle does not alter the fact that the method and materials, including the same poultry, used are the same. The instant rejection is

not on the grounds that the claims present a new use of an old compound. The instant claims are drawn to a method that has the same methods steps taught by the art.

Therefore, the rejection is maintained as '576 anticipates the limitations of claims 1-4,8-14 and 17.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The rejections of claims 1-6,10,11,13,14 and 17, under 35 U.S.C. 103(a) as obvious over Adalsteinsson (US 6,086,878, effective filing date August 21, 1997) is maintained. The rejection under 35 U.S.C. 103(a) is maintained and newly applied to claims 29 and 30 for reasons presented in the office action mailed 09/01/2004 and for further reasons set forth below.

As set forth on pages 10-11 of the office action mailed 09/01/2004, Adalsteinsson taught a method for increasing the live weight of poultry using spray dried egg yolk or plasma as a supplement in feed and water.

Applicant has argued that '878 is directed to methods of administering antibodies to animals to increase muscle proteins and that the instant claimed methods do not involve antibodies. In response, '878 teaches using spray-dried plasma in place of spray-dried egg (col.2, lines 6-8; col. 7, lines 39-41; col. 8, lines 60-65). Adalsteinsson taught feeding the spray-dried egg yolk or plasma as a feed supplement. That Adalsteinsson did so for the benefit of antibodies on muscle protein does not overcome the teachings of the claimed methods by '878. '878 teaches

the method steps, and, as set forth for the 102 rejection above, such method steps would inherently result in the increase in breast meat at the expense of thigh and leg meat in poultry. Since it does not appear that the methods are different or that the plasma administered would be structurally or compositionally different than that of Adalsteinsson, then it is an inherent property of the methods taught by Adalsteinsson, being the same as those of the instant invention, that the methods will preferentially increase the yield of white meat from the poultry. The preferential increase in white meat as claimed in the instant invention is merely an unrecognized property of the methods of Adalsteinsson (see above).

Applicant argues *In re Shetty* where the court found that a new use in suppressing appetite of a compound that was similar to an old compound used in combating microbial infection was not obvious. In response, the instant rejection is not on the grounds that the claims present a new use of an old compound. The instant claims are drawn to a method that comprises methods steps made obvious by the art.

Thus, the claimed invention is clearly *prima facie* obvious in the absence of evidence to the contrary.

Claim Rejections - 35 USC § 102/103

Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Weaver (US 6,004,576, 1999).

Applicant has not provided any additional arguments pertaining to this rejection. Applicant's arguments in the reply of 10/31/2005 were addressed in the advisory action of 03/06/2006.

Conclusion

No claim is allowed.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Valarie Bertoglio whose telephone number is (571) 272-0725. The examiner can normally be reached on Mon-Thurs 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735735. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Valarie Bertoglio
Examiner
Art Unit 1632